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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/648,701	08/26/2003	Shin-Fu Lin	3304.2.82	4049
21552	7590	11/02/2004	EXAMINER	
MADSON & METCALF GATEWAY TOWER WEST SUITE 900 15 WEST SOUTH TEMPLE SALT LAKE CITY, UT 84101			SELLS, JAMES D	
			ART UNIT	PAPER NUMBER
			1734	

DATE MAILED: 11/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/648,701	LIN, SHIN-FU	
	Examiner	Art Unit	
	James Sells	1734	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-16 and 18-20 is/are rejected.
- 7) ☒ Claim(s) 17 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>7-12-04</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

2. Claims 1, 4, 9, 12 and 16 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by CN-2511607Y.

Regarding claims 1 and 9, CN-2511607Y discloses a laminating apparatus including a heating roller. As shown in the figures, the apparatus comprises roller 5, heating roller including a shaft 11, an insulating layer 12, an electro-thermo wire 13, an outer insulating layer 14, a conductive sleeve member 15, an insulating sleeve member 2 and a conductive spring 17. Power is transmitted from a power supply (not shown) through the conductive spring to the electro-thermo wire (see abstract, lines 11-17). The electro-thermo wire heats the roller during laminating in the manner claimed by the applicant.

The applicant is reminded that the materials used (i.e. a sheet material between a pair of thin films) are not germane to the patentability of an apparatus claim.

Regarding claims 4 and 12, Fig. 2 of CN-2511607Y shows shaft 11 with circumferential recesses at the ends thereof. These recesses, in conjunction with members 2, confine the power transmitting conductive springs 17 in the manner claimed by the applicant.

Regarding claim 16, Fig. 3 of CN-2511607Y shows roller 5 with the same construction and configuration as roller 1. Therefore it is the examiner's position that roller 5 contains the same elements (i.e. shaft 11, insulating layer 12, electro-thermo wire 13, insulating layer 14, sleeves 2 and 15, and conductive spring 17) as those described in roller 1

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2-3, 10-11 and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over CN-2511607Y as described above.

Regarding claims 2-3, 10-11 and 19-20, it is the examiner's position that metal and conductive rubber are well known, conventional materials with which to fabricate conductive elements. Therefore it would have been obvious to one having ordinary skill in the art to employ metal or conductive rubber to fabricate the conductive spring in the device of CN-2511607Y described above in order to facilitate power transfer from the power supply to the electro-thermo wire.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the

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art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 5-8 and 13-15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Regarding claims 5 and 13, the examiner does not understand how the clipping element penetrates through the slit of the shaft sheath to engage with the rotating shaft at the recess so as to compress the power transmitting and resilient member between the shaft sheath and the axial end surface of the rotating shaft. In particular the examiner does not understand how applicant's clipping element 55 can compress and continuously urge against the metallic spring 53 between the shaft sheath 54 and the axial end surface of shaft 51 as described on page 8, lines 12-16 of applicant's specification since applicant's Fig. 3 shows that the clipping element does not directly engage the spring.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claim 18 recites the limitation "said first and said second conductive liners" in lines 1-2. There is insufficient antecedent basis for this limitation in the claim.

Allowable Subject Matter

9. Claim 17 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

10. The following is a statement of reasons for the indication of allowable subject matter:

The prior art does not teach or make obvious the concept of a first conductive liner interfacing between the first electro-heating shaft and the axial end surface of the first power transmitting and resilient member, and a second conductive liner interfacing between the second electro-heating shaft and the axial end surface of the second power transmitting and resilient member in the manner recited in applicant's claim 17.

Specification

11. The disclosure is objected to because of the following informalities:

Page 8, paragraph 33, line 2, "sus303" is indefinite and needs to be rephrased.

Appropriate correction is required.

References

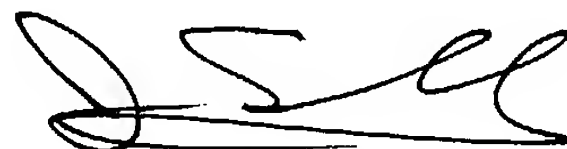
12. References A–B are cited as prior art of interest.

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Telephone/Fax

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Sells whose telephone number is (571) 272-1237. The examiner can normally be reached on Monday-Friday between 9:30 AM and 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Fiorilla can be reached at (571) 272-1187. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.



JAMES SELLS
PRIMARY EXAMINER
TECH. CENTER 1700